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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/114,844	07/14/1998	AVI J. ASHKENAZI	1129R1	9726

7590

07/29/2003

GENENTECH, INC.  
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SOUTH SAN FRANCISCO, CA 94080-4990

EXAMINER

KAUFMAN, CLAIRE M

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 07/29/2003

34

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/114,844

Applicant(s)

ASHKENAZI ET AL.

Examiner

Claire M. Kaufman

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14, 29, 34, 35 and 38-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 29, 34, 35 and 38-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

# 33/6  
7-24-83

### **DETAILED ACTION**

#### ***Continued Prosecution Application***

The request filed on June 2, 2003, for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/114,844 is acceptable and a CPA has been established. An action on the CPA follows.

### **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Authorization for this Examiner's amendment was given in a telephone interview with Diane L. Marschang on July 24, 2003.

The application has been amended as follows:

In claim 40, lines 3 and 5, replace "comprising" with --consisting of--.

#### ***Response to Amendment***

The rejection of claims 6, 40 and dependent claims under 35 USC 112, second paragraph, is withdrawn in view of the amendment to the claims.

The rejection of claims 40, 42-48, 51 and 58 under 35 USC 112, first paragraph, is withdrawn in view of the above Examiner's amendment.

The objection to claims 48 and 58 is withdrawn in view of the amendment to the claims.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 102/103***

Claims 1-6, 8-14, 29, 38-45, 47-55, 57 and 58 remain rejected under 35 U.S.C. 102(e) as being anticipated by Ni et al. (US Patent 6,124,580) for the reasons set forth in the previous Office action (paper #26) on pages 4-5.

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Claims 1-14, 29, 34, 35 and 38-58 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ni et al. (US Patent 6,124,580) for the reasons set forth in the previous Office action (paper #26) on page 5.

Applicants' arguments addressing the rejections under 35 USC 102 and 103 are the same as previously set forth in paper #24, pages 8-11. The arguments have been fully considered, but remain not persuasive for the reasons of record.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Claire M. Kaufman, whose telephone number is (703) 305-5791. Dr. Kaufman can generally be reached Monday through Thursday from 8:30AM to 12:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached at (703) 308-6564.

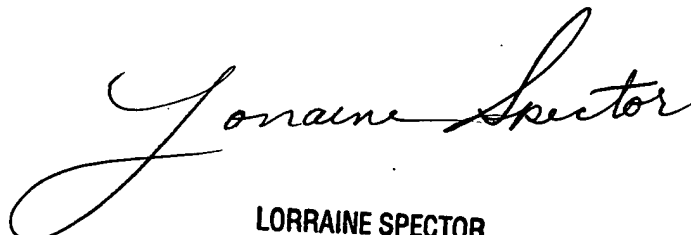
Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. NOTE: If applicant *does* submit a paper by fax, the original signed copy should be retained by the applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office. Please advise the examiner at the telephone number above before facsimile transmission.

Claire M. Kaufman, Ph.D.

Patent Examiner, Art Unit 1646

July 24, 2003

  
LORRAINE SPECTOR  
PRIMARY EXAMINER